

### **REMARKS**

Claims 1-42 are currently pending in the application. By this amendment, the specification at lines 6 and 9 is amended for informalities. Support for the amendment(s) is provided in at least Figure 3. No new matter is added. Reconsideration of the objection to the drawings and the rejected claims in view of the above amendments and the following remarks is respectfully requested.

#### ***Objection to Drawings***

The drawings were objected to for including reference numbers 316 and 320 in Figure 3 which were not referenced in the specification. By this amendment, the specification is amended at page 17, lines 6 and 9 to include reference numbers 316 and 320, respectively. Applicants respectfully requests that the objection to the drawings be withdrawn.

#### ***35 U.S.C. §102 Rejection***

Claims 1-12, 16-28 and 32-39 were rejected under 35 U.S.C. §102(b) for being anticipated by U. S. Patent No. 5,796,952 issued to Davis, *et al.* ("Davis"). This rejection is respectfully traversed.

The invention is directed to client-server computer systems, and more specifically to information access requests to a web site server over a global communications network from a user. The invention allows a server from which a web page originates to record user activity regarding the web page despite the web page contents being cached at another location. The invention provides a system and method for a server network element to obtain enriched data from the user of a cached web page by receiving a single pixel GIF request with enriched data contained therein.

An embodiment of the invention includes a system for obtaining enriched activity data in a client-server communications network where information requested by a network element is

cached at one or more other network elements. The embodiment includes having a server network element including server software and a database for generating and storing a plurality of information files that are accessible to a requesting network. The information files include text files and key words that are interpreted by the requesting network element to display the information requested. The information file further includes an uncacheable single pixel Graphic Image Format (GIF) request. Additionally, the system includes whereupon interpreting the information file, the single pixel GIF request is transmitted from the requesting element over the communications network to the server network element which reads and stores enriched data contained therein.

When a user opens a web page, the information from which the web page is built upon may be stored in various places such as a cache on the user's computer, a cache on an originating server from which the web page originates, or a cache on another server. Consequently, the request for information generated by the user opening the web page may not be received by the server from which the web page originates if the information is cached at a source such as the user's computer or another server. Thus, a program resident on the originating server monitoring the web page's activity may not necessarily be aware each time the web page is opened because the request for the information on the web page may be entirely satisfied by caches at the user's computer or other servers.

By use of the invention, when the originating server receives the request for the single pixel clear GIF, the originating server can determine the source of the request, or what other information is contained on the web page by receiving the single pixel clear GIF request encoded with enriched data. This enriched data may include the URL of the requesting computer, as well as information about the contents of the requested web page. Accordingly, when the originating server receives a request for the single pixel clear GIF having the enriched data, the web server is able to record the enriched data despite the requested web page being cached at other locations.

Davis is directed to a method and apparatus for tracking client interaction with a network resource and creating client profiles and resource database including monitoring client use and

interaction with a resource downloaded from a server on a computer network. The Davis method and apparatus is also used for storing monitored data, for creating a database including profiles indexed by user and/or resource identity, and for generating customized resources based upon client profiles. However, Davis does not disclose the use of an uncacheable single pixel GIF file with encoded data therein so the originating server may gather information about the requesting web page despite the web page being cached on another server.

In operation, the system of Davis includes a tracking program which is embedded in a file which is downloaded from a server to a client. After being downloaded, the tracking program runs on the client to monitor various indicia such as lapse time, mouse movements, keyboard events, and the like, in order to track user interaction with and use of the web page and to monitor choices made by the user. After monitoring the user's interaction, the tracking program then automatically sends the information acquired from the client back to a server for storage and analysis. However, for example, the information is not sent in the form of an uncacheable single pixel GIF request. Additionally, the information is not necessarily sent back to the web page's origination server. Thus, the Davis system does not anticipate at least an uncacheable single pixel GIF request being sent to the originating server.

In one embodiment of Davis, the tracking program is embedded in an HTML document such as a web page and contains text and one or more first embedded URLs for pointing to one or more graphical images located on a server, the image being embedded inside the HTML document. The HTML document contains embedded URLs for pointing to executable programs that run on a server. When a user attempts to fetch a resource associated with one of the executable programs, the client causes the program to run on the server, thereby capturing identifying indicia from the client. This information is then stored on the server for later analysis.

In other words, a web page is requested by the document from a first server "A." This web page contains embedded URLs that point to graphical images also located on the first server A. These images will be fetched by the client from server A when the web page is opened. The

web page additionally includes embedded URLs which point to two resources that reside on a second server "B." One of the resources is an executable program which executes on server B, and is a CGI script. This CGI script causes the return of information output from the script to the client. The other resource also located on server B and is CGI script which can obtain information tracked and transmitted by another applet, as well as any available information in the HTTP request header. This information can be stored in a database on server B or elsewhere.

In this case, the HTML document may contain text as well as embedded URLs that point to GIF image files located on a server. These GIF images may be fetched by the client and include URLs which point to documents, including CGI script which forces execution of the CGI script when the image is requested. When the CGI script executes, it collects information which is returned to the client or a server. Thus, information is collected and returned to either the client or a server. If the program was cached, the information will be returned to the caching server. In another example, when a user opens a web page, the user's computer will automatically fetch a resource associated with a <IMG> tag on a second server which will result in execution of a CGI script. This CGI script can capture client information such as network ID or client ID, and may also return a transparent image.

However, in both of the above examples, the CGI script is required in order to collect information and return the transparent image. This CGI script causes the return of the transparent image to the computer on which the CGI script is run which would be a caching server for a cached CGI script. None of the servers mentioned by Davis are indicated to be the web page's originating server and thus may be servers functioning as caches. Consequently, Davis does not show returning an uncacheable single pixel request to the originating server with enriched data contained therein.

Accordingly, Davis does not disclose obtaining enriched activity data wherein a single pixel GIF request is transmitted from a requesting element over a communications network to a server element which reads and stores enriched data contained therein, as set forth in claims 1, 17 and 32.

Thus, independent claims 1, 17 and 32 are not anticipated by Davis and are in allowable condition. Claims 2-12, and 16, 18-28, and 33-39 are allowable at least for the reasons set forth above with respect to independent claims 1, 17 and 32, from which they respectively depend, as well as for their added features. Accordingly, Applicants respectfully request that the rejection of claims 1-12, 16-28 and 32-39 be withdrawn.

### ***35 U.S.C. §103 Rejection***

Claims 13-15, 29-31 and 40-42 were rejected under 35 U.S.C. §103(a) for being unpatentable over Davis in view of U. S. Patent No. 6,085,229 issued to Newman, *et al.* ("Newman"). This rejection is respectfully traversed.

Applicants note that a §103 rejection requires the Examiner to first establish a prima facie case of obviousness: "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. § 2142. The Court of Appeals for the Federal Circuit has set forth three elements which must be shown for prima facie obviousness:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

For the reasons set forth below, the Examiner has not set forth a prima facie case of obviousness with Davis and Newman.

In an embodiment of the invention, the system for obtaining enriched activity data includes the single pixel GIF request with an appended CGI query string and is included as part of a JavaScript command that is put directly into the HTML file. A further embodiment includes the JavaScript command being a "document.write" command which places an expression that follows the command into a document window. However, the Newman system teaches away from the invention because it is specifically designed to not send information to the originating server in the form of a single pixel GIF file. Additionally the combination of Davis and Newman does not establish a prima facie case of obviousness because it does not show or suggest sending an uncacheable single pixel GIF request with enriched data activity contained therein to a server.

Instead, Newman is directed to a system and method for providing client-side personalization of content of web pages and the like where the client computer processes a set of conditional items in conjunction with personal information maintained by a client computer. Newman is further directed to having selection criteria to identify one of a conditional content items to be displayed or to be used in obtaining supplemental content item to be displayed in a web page.

The system of Newman provides the advantage that the personal information need not be provided to or otherwise obtained by the originating server to allow for personalization of the web page on the user's computer. If certain conditions are met, the user computer may then send requests for certain types of information based on the user's computer to an originating server so that the originating server may add supplemental information to the web page being displayed on the user's computer. If certain conditions are true, JavaScript will execute "document.write" functions. Such JavaScript commands are processed by the client computer as a plug-in, also known as a MIME type content. Thus, the JavaScript of Newman is not part of an uncacheable single pixel GIF request.

The "document.write" command appears in the fifth line of the JavaScript in the web page at a position corresponding to a position where an advertisement on the web page is to appear. If the conditional item selection processor determines that a particular parameter of the

JavaScript language evaluates to “true,” it will set the value of the parameter and will process the “document.write” function. Thus, the JavaScript command of Newman is part of a set of conditional items which may or may not be executed and is provided at a location in a web page at which an advertisement is to appear. User information is specifically not sent to the originating server, and no uncacheable single pixel GIF files are sent to the originating server.

Davis transfers GIF files which are located on a server where the CGI script contained therein is executed to collect information. The collected information is then returned to the client computer as a GIF image. However, Newman does not send an uncacheable single pixel GIF request to an originating server, and furthermore, specifically avoids sending any user information to a server.

Accordingly, Newman teaches away from the invention, and there is no motivation to combine Newman with Davis. If it is assumed arguendo that Newman does not teach away, neither Davis or Newman, either alone or in combination, disclose or suggest a system for obtaining enriched activity data for a single pixel GIF request with an appended Common Gateway Interface (CGI) query string is included as part of a JavaScript command that is put directly into an HTML file, as set forth in claims 13 and 29. Additionally, neither Davis or Newman, either alone or in combination, disclose or suggest a computer readable medium containing a computer program for obtaining enriched activity data, including instructions that place a JavaScript command, including a single pixel GIF request with an appended CGI query string directly into an HTML file, as set forth in claim 40. Applicants further note that for the reasons discussed above, neither Davis or Newman, either alone or in combination, disclose or suggest a system or computer readable medium containing a computer program for obtaining enriched activity data wherein a JavaScript command is a “document.write” command which places an expression that follows the command into a document window, as set forth in claims 14, 30 and 41. Accordingly, claims 13-15, 29-31 and 40-42 are in allowable condition.

Applicants respectfully request that the rejection of claims 13-15, 29-31 and 40-42 be withdrawn.

Paul BRISCOE, et al.  
Serial No.: 09/641,495

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### CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 09-0457.

Respectfully submitted,

A handwritten signature in black ink, reading "Randall H. Cherry". The signature is fluid and cursive, with the first name "Randall" being the most prominent.

Randall H. Cherry  
Registration No. 51,556

Andrew M. Calderon  
Registration No. 38,093

McGuireWoods, LLP  
Suite 1800  
1750 Tysons Blvd.  
McLean, VA 22102  
(703) 712-5426